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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,747	11/20/2000	Benyahia Nasli-Bakir	ANO 6441 PIUS/5116	4239

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1792

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/700,747

Applicant(s)

NASLI-BAKIR ET AL.

Examiner

William P. Fletcher III

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39,41-46,56-76 and 78-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39,41-46,56-76 and 78-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/31/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007, has been entered.

Response to Amendment

2. Claims 39, 41-46, 56-76, and 78-98 are now pending.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on October 31, 2007, simultaneously with the RCE. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

4. Applicant's arguments filed October 31, 2007, have been fully considered but they are not persuasive.

A. Applicant argues: "The Office Action provides no rationale for substituting an amino resin for the phenolic resin in Andersson. The only basis offered for such a substitution is the bare assertion in Lehnert that the resins are equivalent.

However, Applicants respectfully submit that conventional does not mean equivalent" [remarks, p. 16]. The Examiner disagrees. While the particular definitions Applicant wishes to apply to the terms "equivalent" and "conventional" are noted, the fundamental level of inquiry rests at *functional equivalency* not compositional sameness. See MPEP 2144.06. Applicant argues that, because phenolic and amino resins systems are not compositionally identical, they are not equivalent: "If phenol and amino resins were 'equivalent' or 'essentially equal,' they would not employ totally different chemistries, requiring hardeners with diametrically opposing properties, viz., acidic vs. basic" [remarks, p. 16]. In other words, Applicant argues that, because the compositions are not identical, they cannot render the claim obvious by virtue of their equivalency. This argument is flawed: it is essentially stating that, since the claims are not anticipated, they cannot be obvious. As such, it is not persuasive and it remains the Examiner's position that the amino resin systems and phenolic resin systems are *functionally equivalent* to join wood. Further, the Examiner notes that obviousness need not be based only on functional equivalency. Rather, materials may be selected based upon their art-recognized suitability for the intended purpose. It is clear from the cited references that both phenolic and amino systems are suitable to join wood.

B. Applicant further argues that replacing the phenolic resin system of Andersson with an amino resin system would destroy the reference's intended function. The Examiner disagrees. Andersson's intended function is adhesively

joining two pieces of wood, not selecting the pH of the hardener. It is clear that substitution of one resin system for another would inherently require associated changes in hardener, but would not change the overall process steps of application in strand-form by an applicator followed by joining. Since it is clear from Andersson in view of Lehnert that either system would successfully join wood, the reference's intended function is retained, not destroyed. As such, this argument is not persuasive.

C. Applicant argues that the Office contradicts its own rationale of equivalency and that Applicant's Example I provides evidence of unexpected results. This is not correct. The issue in the Interview Summary (10/13/2005) is that of the burden on Applicant to establish unexpected results. Unexpected results must be commensurate in scope with the claimed invention. See MPEP 716.02(d). Example I shows results for a specific amino resin compound, melamine-urea-formaldehyde, while the claim broadly recites an "amino resin gluing system." Clearly the two are not commensurate in scope. A proper showing must be made before the showing can be weighed against the *prima facie* case of record and the criteria of a proper showing, as established by the Office, cannot be used as rationale for why any showing need not be made or why the claims are non-obvious absent a showing.

D. With respect to Applicant's arguments vis-à-vis various dependent claims at pages 18-20 of the remarks, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure

of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

E. Applicant has not presented any specific argument against the other objections and rejections set forth in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006. These objections and rejection are maintained herein below.

Specification

5. The specification is objected to for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

Claim Objections

6. Claim 98 is objected to because of the following informalities: "timer" should, apparently, read "timber." Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claim 94 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. This claim is rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claim 94 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A. This claim is rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 39, 41-45, 56-59, 70-76, 78-82, 84-87, 89-93, 95, and 98, are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1).

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

14. Claims 46, 83, 88, 96, and 97, are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert, as applied to claims 49, 80, and 87, respectively, above, in further view of Perciwall (EP 0 016 740 A1).

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

B. With specific respect to new claim 96, as first noted by the Examiner in the Office action mailed January 14, 2005, not yet traversed by Applicant, it is clear that, as soon as the components are mixed, curing begins. The particular physical orientation of the strands on the substrate effects the speed and degree of curing; such would have been readily apparent to one of ordinary skill in the art. Consequently, absent clear and convincing evidence to the contrary, it would have been obvious to select the orientation of resin and hardener strands to give the desired curing rate and substrate coverage. In other words, for a quicker

cure, strands are applied with a greater degree of overlap so that curing may begin before the substrates are joined. The apex of such overlap being applying hardener directly on top of the resin. This arrangement inherently prevents contact of the volatile acid in the hardener with the substrate. For a longer cure, strands are applied with a lesser degree of overlap.

C. With respect to new claim 97, differences in concentration will generally not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such subject matter is critical. Further, the ratio of hardener to resin is a result-effective variable effecting the rate and degree of hardening. As such, it would have been obvious to one skilled in the art to optimize this result-effective variable by routine experimentation, absent evidence of criticality. See MPEP 2144.05.

15. Claims 40 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert, as applied to claims 39 and 76, respectively, above, and further in view of Menger (US 2,015,806 A).

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

16. Claims 60-64 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert and Toshio (JP 61-040137).

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

17. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert and Toshio, as applied to claim 60 above, and further in view of Perciwall.

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

18. Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert and Perciwall.

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 70 and 76 are each rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 18 of U.S. Patent No. 6,734,275 B2 in view of Andersson (EP 0 207 024 A2).

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

21. Claim 94 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 18 of U.S. Patent No. 6,734,275 B2 in view of Perciwall (EP 0 016 740 A1 and Andersson (EP 0 207 024 A2).

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

Conclusion

22. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner